

Remarks

Claims 1-38 are currently pending in the patent application, of which claims 14-19, 25, 27, 29-31, 33 and 36 have been withdrawn. For the reasons and arguments set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

In the instant Office Action dated August 13, 2007, the following rejection is noted: claims 1-13, 20-24, 26, 28, 32, 34, 35, 37, and 38 stand rejected under 35 U.S.C. 103(a) over Greanias *et al.* (U.S. Patent No. 5,386,219) in view of Saif *et al.* (U.S. Patent No. 6,583,935). Applicant disagrees.

The Office Action alleges that a *prima facie* case of obviousness has been stated by combining Greanias (disclosing a patterned conductor touch sensitive overlay) with Saif (disclosing a touch panel membrane having an anti-reflective stack). It is admitted in the Office Action that Greanias does not disclose (1) a coating that substantially covers the substrate and disposed between the substrate and a pattern of transparent conductors, or (2) a coating between the transparent conductor pattern and the substrate having a refractive index less than that of the substrate and less than that of the transparent conductor pattern. It is argued that one of skill in the art would modify Greanias using the teachings of Saif to produce Applicant's invention. This argument fails on several levels.

Saif is understood to disclose a touch panel membrane having an anti-reflective stack of layers, each of the layers being continuous over the substrate, and none of the layers being patterned. In contrast, Greanias discloses a set of conductive lines disposed directly on a substrate with no coating between. As understood by Applicant, the position stated in the Office Action is that one of skill in the art would recognize that the anti-reflective stacks of Saif could be employed to reduce reflections from the conductive lines of Greanias. However, even if this were so, the resulting combination would not result in Applicant's claimed invention, but rather in a pattern of anti-reflective stacks, if anything. Applicant finds nothing in the cited references to teach or suggest a patterned transparent conductor disposed on a continuous coating covering the substrate so that areas of the coating are exposed, and then over-coating with a filler material.

Applicant submits that the Office Action has impermissibly, and with the benefit of hindsight, chosen a portion of the anti-reflective stack of Saif and inserted it between existing elements of Greanias without providing any basis for how, why or whether such a thing could be done. In so doing, the Office Action has selected only those portions of the references deemed supportive of the rejection while ignoring the teachings as a whole, contrary to settled law as stated in the MPEP at 2141.02, “A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).”

The Office Action has further failed to address the substance of Applicant’s arguments as presented in the response transmitted on May 18, 2007, which arguments are hereby incorporated into the present remarks. In particular, the Office Action does not address why one of skill in the art would seek to include a coating covering the substrate of Greanias underneath the patterned conductor when the reference clearly suggests a desire to decrease the distance between the touch input and the conductive sensors. The Office Action relies solely on the desire for reduced reflections as identified in Saif without regard for how to resolve the differences in device construction in Saif and Greanias, or how the proposed combination could be implemented in light of the purposes disclosed in the references.

Each of Applicant’s claims recites a coating covering a substrate, a transparent conductor pattern over the coating, and a filler material covering the transparent conductor pattern and exposed portions of the coating. The proposed combination does not teach or suggest such a construction, and no reason has been provided as to why one of skill in the art would make the necessary modifications in the face of contrary teachings present in the references. Therefore, a *prima facie* case of obviousness has not been stated, and Applicant requests reconsideration and withdrawal of the rejection.

Furthermore, because the rejection fails to state a *prima facie* case of obviousness in view of the elements of the independent claims, it is not necessary to argue additional grounds for allowance based on the dependent claim recitations. Contrary to the statement in the Office Action, Applicant has not and does not acquiesce in any aspect of

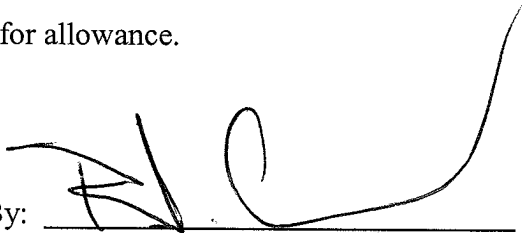
the rejection as applied to additional elements of the dependent claims, and reserves all right to separately argue those additional elements.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance.

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